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EXAMINER

PAK, HANNAH J

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Attachment to Box 11:**

The arguments filed 01/21/2009 have been considered, but are not persuasive. Specifically, the applicants appear to argue that A) Mortimer et al. fail to teach grinding of an inorganic particulate material in the presence of any dispersant, let alone in the presence of a sub-effective amount (see Pages 11-12 of the Applicants' Remarks). The applicants also argue that B) Egraz et al. fail to teach the sub-effective amount (see Pages 13-14 of the Applicants' Remarks). The applicants rely on examples of Egraz et al. to show that Egraz et al. never contemplated the use of a sub-effective amount.

With respect to argument A), Mortimer et al. teach adding dispersing agent in at least one step prior to or during step (C) in a total effective amount of from 0.01-2% by weight based on the dry weight of the carbonate present (Col. 4, lines 1-5 and Col. 8 lines 24-30). The phrase "at least one step prior to step (C)" disclosed in Mortimer et al. can include steps (A) or (B) in Col. 2, lines 5-10. Therefore, the dispersants can be added to steps (A), (B) or (C), which involve the method of grinding the calcium carbonate. In other words, the dispersants can be added during the grinding of the inorganic particulate material. The claims also do not specifically indicate the dispersants to be added during the grinding of the inorganic particulate material.

With respect to argument B), the applicants admit on page 14 of the Applicants' Remarks that Egraz disclose that its grinding/dispersing agent may be used in the proportion from 0.2-2% by weight of the dried fraction of said polymers, in relation to the dry weight mass of the mineral substances to be fined (Col. 5, lines 19-26). The amount, 0.2-2% by weight, is encompassed by the amount disclosed in Mortimer et al.

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and overlaps with the claimed amounts. The definition of the term “sub effective-amount” is discussed in the Final rejection filed 10/17/2008. Furthermore, the prior art (Egraz et al) is not limited to the examples (examples 1-19) the applicants point out on page 14 of the Applicants' Remarks.

/Hannah Pak/

Examiner, Art Unit 1796

/Vasu Jagannathan/

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